



UNITED STATES PATENT AND TRADEMARK OFFICE

m-f

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/782,594

02/18/2004

Thomas Francis Doyle

020122

6306

23696

7590

09/13/2006

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

EXAMINER

NGUYEN, TUAN HOANG

ART UNIT

PAPER NUMBER

2618

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/782,594	Applicant(s) DOYLE ET AL.	
	Examiner Tuan H. Nguyen	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-12, 15-20, 22-27, 30-33, 36-39, and 41-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Keillor et al. (US PAT. 5,917,433 hereinafter, "Keillor").

Consider claims 1, 17 and 38, Keillor teaches for making an asset apparent to an individual, comprising: a receiver for receiving a request directly from a wireless communication device for having the asset make itself apparent and providing the request to a processor (col. 4 lines 23-32); the processor for receiving the request, for determining how to make the asset apparent (col. 10 lines 47-64); and for generating a command to make the asset apparent (col. 10 lines 47-64); and an interface for providing the command to a device on the asset, the device for making the asset apparent to the individual (col. 15 lines 40-50).

Consider claims 2 and 18, Keillor further teaches the device comprises illumination circuitry (col. 7 lines 55-65).

Consider claims 3 and 19, Keillor further teaches the device comprises audio control circuitry (col. 7 lines 55-65).

Consider claims 4, 20 and 39, Keillor further teaches request comprises a selected appetency action and processor generates command based on selected appetency action (col. 10 lines 47-64).

Consider claims 6, 22, and 42, Keillor further teaches a timer for providing an elapsed time to processor for determining whether the asset was located prior to expiration of a predetermined amount of time for locating the asset (col. 3 lines 45-54).

Consider claims 7, 23 and 43, Keillor further teaches processor generates a message indicative of whether the asset was located prior to expiration of the predetermined amount of time (col. 13 lines 1-25), wherein apparatus further comprises a transmitter for transmitting the message to a remote entity (col. 13 lines 26-35).

Consider claims 8, 24 and 44, Keillor further teaches a timer for determining the current time of day and providing the current time of day to the processor for using the

current time of day for determining a way in which to make the asset apparent (col. 11 lines 39-48).

Consider claims 9, 25 and 45, Keillor further teaches a position sensor for determining a location of the asset (col. 1 line 58 through col. 2 line2); wherein request comprises a location of an individual requesting that the asset make itself apparent (col. 4 lines 23-32), and processor is further for using the location of the asset and the location of the individual for determining a way in which to make the asset apparent (col. 15 lines 40-50).

Consider claim 10, Keillor teaches wireless communication device for making an asset apparent to an individual, comprising: an input for allowing the individual to enter an identification code corresponding to the asset (col. 3 lines 45-54); a processor for receiving the input and generating a request to make the asset apparent, the request including the identification code (col. 10 lines 47-64); and a transmitter for transmitting the request to the asset (col. 11 lines 49-63).

Consider claim 11, Keillor further teaches transmitter comprises a cellular transmitter (col. 9 lines 15-33).

Consider claim 12, Keillor further teaches the input is further for receiving a selected method of asset appetency and wherein the request further comprises the

selected method (col. 10 lines 47-64).

Consider claim 15, Keillor further teaches a position detector for determining a current location of the wireless communication device (col. 3 lines 36-44); wherein the request further comprises the current location of the wireless device for use in determining an appetency action (col. 1 line 58 through col. 2 line 2).

Consider claim 16, Keillor further teaches a timer for determining the current time of day (col. 11 lines 39-48); wherein the request further comprises the current time of day for use in determining an appetency action (col. 11 lines 39-48).

Consider claims 26 and 32, Keillor teaches signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing to perform a method for making an asset apparent, method comprising operations of: receiving an identification code corresponding to asset (col. 10 lines 47-64); generating a request to make asset apparent (col. 7 lines 18-30); and transmitting request to asset corresponding to identification code over a wireless communication network (col. 4 lines 23-32).

Consider claims 27 and 33, Keillor further teaches operations of: receiving a selected appetency method from a requesting individual (col. 10 lines 47-64); wherein

Art Unit: 2618

the operation of generating a request to make asset apparent comprises the operation of including selected appetency method along with request (col. 10 lines 47-64).

Consider claims 30 and 36, Keillor further teaches operations of: determining a current location of the signal-bearing medium (col. 3 lines 36-44); wherein the operation of generating a request to make said asset apparent comprises the operation of including said current location of the signal-bearing medium for use in determining an appetency action (col. 1 line 58 through col. 2 line 2).

Consider claims 31 and 37, Keillor further teaches operations of: determining the current time of day (col. 11 lines 39-48); wherein the operation of generating a request to make said asset apparent comprises the operation of including said time of day for use in determining an appetency action (col. 11 lines 39-48).

Consider claim 41, Keillor further teaches determining an elapsed time since the request was received (col. 3 lines 45-54); determining whether the asset was located prior to expiration of a predetermined amount of time (col. 3 lines 45-54).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2618

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 13-14, 21, 28-29, 34-35, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keillor et al. (US PAT. 5,917,433 hereinafter, "Keillor") in view of Milenkovic (U.S PUB. 2005/0145688).

Consider claims 5, 21, and 40, Keillor teaches for making as asset apparent. An individual wishing to locate an asset uses an apparatus to enter an identification code corresponding to the asset.

Keillor does not explicitly show that processor generates a list of available appetency actions in response to receiving request and further comprises a transmitter for transmitting the list of available appetency actions to a remote entity; wherein receiver receives a second request for making asset apparent, second request comprising a selected appetency action from list of available appetency actions.

In the same field of endeavor, Milenkovic teaches processor generates a list of available appetency actions in response to receiving request and further comprises a transmitter for transmitting the list of available appetency actions to a remote entity actions (page 5 [0060]); wherein receiver receives a second request for making asset apparent, second request comprising a selected appetency action from list of available appetency actions (page 5 [0060]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, processor generates a list of available appetency actions in response to receiving request and further comprises a transmitter for

Art Unit: 2618

transmitting the list of available appetency actions to a remote entity; wherein receiver receives a second request for making asset apparent, second request comprising a selected appetency action from list of available appetency actions; as taught by Milenkovic, in order to correlate and track physical and logical attributes of electronic devices.

Consider claim 13, 28 and 34, Milenkovic further teaches an output for providing a list of available appetency actions that the asset is able to perform to the individual (page 5 [0060]); the input further for allowing the individual to select one of the available appetency actions (page 2 [0029]); wherein the processor is further for generating the request based on the selected one of available appetency actions (page 2 [0029] and [0030]).

Consider claims 14, 29 and 35, Milenkovic further teaches a receiver for receiving the list of available appetency actions from a remote entity (page 5 [0060]).

Conclusion

5. Any response to this action should be mailed to:

Mail Stop_____ (Explanation, e.g., Amendment or After-final, etc.)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22313


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571) 272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2618

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan Nguyen
Examiner
Art Unit 2618

 9/05/06
QUOCHIEN B. VUONG
PRIMARY EXAMINER